

# LAHIVE & COCKFIELD LLP

COUNSELLORS AT LAW  
28 STATE STREET  
BOSTON, MASSACHUSETTS 02109-1784  
TELEPHONE (617) 227-7400  
FAX (617) 742-4214  
lc@lahive.com

JOHN A. LAHIVE, JR. (1928-1997)  
THOMAS V. SMURZYNSKI  
RALPH A. LOREN  
GIULIO A. DECONTI, JR.  
ANN LAMPORT HAMMITT  
ELIZABETH A. HANLEY  
AMY BAKER MANDRAGOURAS  
ANTHONY A. LAJAKENTANO  
KEVIN J. CANNING  
JANE E. REMILLARD  
DEANN FORAN SMITH  
PETER C. LAURO  
JEANNE M. DIGIOKOIO  
DEBRA J. MILASINIC, Ph.D.  
DAVID J. BUKKERS  
DAVID R. BURNS  
JOHN S. CURRAN  
SEAN D. DETWILER

CYNTHIA L. KANDL, Ph.D.  
MEGAN E. WILLIAMS, Ph.D.  
RICHARD N. NAD  
MICHAEL PHILLIPPS  
LISA M. DIROCCO  
HATHAWAY P. RUSSELL  
MARIA LACCOTRIPE ZACHARAKIS, Ph.D.  
PETER A. DIMATTIA  
VINCENT P. LOCCESANO  
MEREDITH C. ARNOLD

SENIOR COUNSEL  
JAMES E. COCKFIELD

OF COUNSEL  
JEREMIAH LYNCH  
WILLIAM A. SCOFIELD, JR.  
SHLEY P. REPPERT

PATENT AGENTS  
THEODORE R. WEST  
SHAYNE Y. HUFF, Ph.D.  
DANIEL B. KO

TECHNICAL SPECIALISTS  
CYNTHIA M. SOROOS  
PETER W. DINI, Ph.D.  
SUHOON LEE  
JENNIFER K. ROSENFELD  
ALLAN TAMPSHTIT, Ph.D.  
CATHERINE E. MCGHERSON  
ERIC F. WAGNER, Ph.D.  
SHAHID HASAN, Ph.D.  
JACOB O. WEINTRAUB  
JONATHAN M. SPARKS, Ph.D.  
CHRISTIN E. HOWLEY, Ph.D.

\* Adjusted only  
\*\* Adjusted only

**FAX RECEIVED**

AUG 06 2002

GROUP 1600

## Facsimile Cover Sheet

**To:** Examiner Samuel W. Liu  
**Company:** U.S. Patent and Trademark Office  
**Location:** Washington, D.C.  
**Phone:** 703-306-3483  
**Fax:** 703-308-4242

**From:** Maria C. Laccotripe  
**Phone:** (617) 227-7400  
**Fax:** (617) 742-4214  
**Case No.:** AHN-001DV2  
**USSN 09/658,969**

**Date:** August 5, 2002  
**Sent By:** MCL/kat  
**Pages including this** 9  
**cover page:**

**Message:** Please ENTER AND DELIVER to Examiner Samuel W. Liu  
At Group Art Unit 1653.

The documents transmitted by this facsimile are intended for the use of the individual or the entity to which it is addressed and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of the message is not the intended recipient, or the employee or agent responsible for delivering this document to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original facsimile to us at the above address via the U.S. Postal Service. Thank you.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Winfried Edelmann *et al.*

Serial No.: 09/658,969

Filed: September 11, 2000

For: *METHODS FOR MODULATING THE  
ACTIVITY OF MSH5 (as Amended)*

Attorney Docket No.: AHN-001DV2

Group Art Unit: 1653

Examiner: Samuel W. Liu

Commissioner for Patents  
Washington, D.C. 20231

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Commissioner for Patents,  
Washington, D.C. 20231 on the date set forth below.August 5, 2002

Date of Signature and of Mail Deposit

By: 

Marla C. Laccotripe, Ph.D.

Limited Recognition Under 37 C.F.R. § 10.9(b)  
Attorney for ApplicantsRESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated June 4, 2002 (Paper No. 11). A separate petition for the appropriate extension of time in which to respond is being filed concurrently herewith.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claim 24, drawn to a polynucleotide, classified in class 536, subclass 23.1.
- II. Claim 25, drawn to small molecules that are of non-organic and non-peptide and characteristics, classified in class 260.
- III. Claim 26, drawn to antibody specifically recognizes and binds MSH5, classified in class 530, subclass 387.1.

Serial Number: 09/658,969

-5-

Group Art Unit: 1653

- IV. Claim 27, drawn to polypeptide, classified in class 435, subclass 350, and class 514, subclass 2.
- V. Claim 28, drawn to peptidomimetic substance which is not a polypeptide or peptide, classified in class 564, subclass 152, class 514, subclass 23 and 54.
- VI. Claim 29, drawn to a substance having an effect on substrate for MSH5, substance can be nucleotide, classified in class 435, subclass 89<sup>+</sup>, or other organic compound, classified in class 552, subclass 500<sup>+</sup>.

Applicants hereby elect the Group II invention (claim 25 ) drawn to small molecules, for prosecution in this application, *with traverse*. It is Applicants' understanding that claims 15-17, 22, 23, 30 and 31 will all be examined to the extent that these claims read on the elected invention.

Applicants hereby *traverse* the foregoing Restriction Requirement on the grounds that Groups I-VI should be re-grouped as a single invention, as Groups I- VI encompass inventions which are connected in design, operation, and effect, *i.e.*, are not independent (M.P.E.P. §808.01). Applicants have presented generic claim 15 which is directed to a method for modulating MSH5 expression or activity comprising contacting MSH5 or a cell expressing MSH5 with a compound in a sufficient concentration to modulate MSH5 expression or activity. The *compound that modulates MSH5 expression or activity* can be a small molecule, a polypeptide, a peptidomimetic, an antisense nucleic acid molecule, or an anti-MSH5 antibody. These compounds have the same effect, *i.e.*, they modulate MSH5 activity, and the same design and operation. For example, a peptide, a peptidomimetic and an antibody all operate by binding to an active site on the MSH5 polypeptide, thereby modulating its activity. For the foregoing reasons, Applicants respectfully submit that a sufficient search and examination with respect to the inventions of Groups I-VI can be made without serious burden on the Examiner.

Serial Number: 09/658,969

-5-

Group Art Unit: 1653

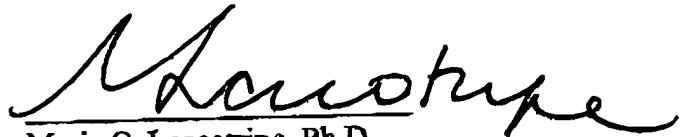
Applicants believe that a *species election*, e.g., wherein the compound is a small molecule, may be proper for searching purposes only, posing no undue burden on the Examiner. However, a restriction under 35 U.S.C. § 121 is improper for the above-stated reasons. Accordingly, Applicants hereby request that the invention of Groups I-VI be combined into a single Group.

Applicants reserve the right to traverse the restriction between the non-elected groups in this or a separate application.

#### SUMMARY

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' Attorney at (617) 227-7400.

Respectfully submitted,



Maria C. Laccotripe, Ph.D.

Attorney for Applicants

Limited Recognition Under 37 C.F.R. § 10.9(b)

LAHIVE & COCKFIELD, LLP  
28 State Street  
Boston, MA 02109  
Tel. (617) 227-7400

Dated: August 5, 2002

**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE  
UNITED STATE PATENT AND TRADEMARK OFFICE**

**LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)**

Maria C. Laccotripe is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Lahive & Cockfield, LLP, to prepare and prosecute patent applications where the patent applicant is the client of Lahive & Cockfield, LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of the Lahive & Cockfield, LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Maria C. Laccotripe ceases to lawfully reside in the United States, (ii) Maria C. Laccotripe's employment with Lahive & Cockfield, LLP ceases or is terminated, or (iii) Maria C. Laccotripe ceases to remain or reside in the United States on an H-1 visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

**Expires: September 4, 2002**



**Harry L. Montz**

**Director of Enrollment and Discipline**